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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
IVAN CLAEYS, ET AL. : EXAMINER: SHORT, P.
SERIAL NO: 10/030,140 :
FILED: APRIL 30, 2002 : GROUP ART UNIT: 171
FOR: THERMOPLASTIC ALIPHATIC :
POLYESTER COMPOSITIONS,
PREPARATION METHOD AND USES
THEREOF

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RESPONSE TO REQUIREMENT FOR RESTRICTION

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

In response to the Official Action of July 18, 2003, Applicants elect, with traverse, Group II, Claims 10-14, drawn to a process of preparing aliphatic polyester compositions comprising reacting an aliphatic polyester and a radical generator in an amount of 0.01 to 0.2 percent in an extruder. In addition, Applicants elect the specie of introducing the radical generator in a mixture with carbon dioxide.

Remarks begin on page 2 of this paper.

REMARKS

The Office has required restriction in the present application as follows:

Group I: Claims 1-9, drawn to thermoplastic aliphatic polyester compositions having an RMFI value of 1.1 to 2.5;

Group II: Claims 10-14, drawn to a process of preparing aliphatic polyester compositions comprising reacting an aliphatic polyester and radical generator in an amount of 0.01 to 0.2 percent in an extruder; and

Group III: Claims 15-21, drawn to films, foams, bottles and thermally molded products.

In addition, if Group II is elected, the Office has required the election of a method of introducing the radical generator.

Restriction is only proper if the claims of the restricted groups are either independent or patentably distinct. The burden of proof is on the Office to provide reasons and/or examples to support any conclusion with regard to patentable distinctness. M.P.E.P. § 803.

Applicants respectfully traverse the requirement for restriction on the grounds that the Office has not provided adequate reasons and/or examples to support a conclusion of patentable distinctness between the identified groups.

The Office states that the inventions of Groups I-III do not relate to a single general inventive concept because WO '169 describes "a process of improving the melt strength and elasticity of polyhydroxy acid compositions comprising reactive extrusion with organic peroxide in amounts as low as 0.05%". However, Applicants traverse the requirement for restriction on the grounds that the Office has not applied the same standard of unity of invention as the International Preliminary Examination Authority. The Authority did not take the position that unity of invention was lacking in the International Application and examined all claims together (see the International Preliminary Examination Report appended

herewith). Applicants note that PCT Article 27(1) states that no national law shall require compliance with requirements relating to the form and content of the International Application which are different from or additional to those which were provided for in the Patent Cooperation Treaty and the Regulations.

Moreover, this application is a 371 of International Application PCT/EP00/07274, filed July 25, 2000, and is therefore properly subject to restriction only under the PCT rules. As noted in M.P.E.P. § 1895.01(D), restriction practice under 35 U.S.C. § 121, as it applies to national applications submitted under 35 U.S.C. § 111(a), it is not applicable to a national stage application such as this one. Since the PCT rules do not provide for election of species, Applicants respectfully submit that the requirement for election of species is improper, and should be withdrawn.

Finally, MPEP § 803 states:

“If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.”

Applicants respectfully submit that a search of all the claims would not impose a serious burden on the Office.

Accordingly, and for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the requirement for restriction. Applicants therefore request that the requirement for restriction be withdrawn.

Application No. 10/030,140
Reply to Office Action of July 18, 2003

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice thereof is earnestly solicited.

Respectfully submitted,

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